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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/541,935 | 07/08/2005 | Werner Reinhart | 1093-133 PCT/US | 8481 |
| 23869 | 7590 | 07/01/2008 | | |
| HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791 | | | EXAMINER BATTULA, PRADEEP CHOUDARY | |
| | | | ART UNIT 3725 | PAPER NUMBER |
| | | | MAIL DATE 07/01/2008 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|---|--|
| Office Action Summary | Application No. 10/541,935 | Applicant(s) REINHART, WERNER | |
| | Examiner PRADEEP C. BATTULA | Art Unit 3725 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/17/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to the reply filed on February 1, 2008

Information Disclosure Statement

The information disclosure statement filed December 17, 2007 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1, 2, 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitations of “human sense of touch” and “through which the surface of the substrate can be felt”, or any similar reference, does not provide a set structure to the invention. The human sense of touch varies from person to person and many blind individuals have a sense of touch that is much more sensitive than that of individuals who are not blind.

Claims 3 – 9 and 11 - 19 are further rejected as being dependent from independent claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka et al. (Tanaka; U.S. 5,582,103).

In regards to Claim 1, Tanaka discloses a security document, in particular a value-bearing paper (Column 1, Lines 39 – 43), comprising at least one security element 1a provided on a surface of the substrate forming the security document (Column 3, Lines 12 - 15), wherein to form the security element at least one surface region (having elements 2₅ and 2₆) of the security document is of a configuration and size specific to the respective security document in such a way and is spatially displaced, for example recessed or raised, at least relative to the surface of the substrate which is adjacent or surrounding the surface region (Column 3, Lines 16 – 31; Figure 4, Items 1a, 2₅ and 2₆; Shows that a film is provided on the substrate in the form of an ink) , and/or is of such a different roughness, hardness, elasticity, slipperiness, thermal conductivity and/or stickiness (Column 3, Lines 12 – 31; teaches that the substrate is paper and the ink film is ink and it is inherent they have at least a different roughness), that the configuration and size of the surface region can be established as a consequence of the differing surface nature thereof by means of the human sense of touch (many blind individuals can feel differences in materials and raise surfaces so at

least a blind person can feel the difference in the raised portions of the substrate and then dropping to the ink pattern), and wherein the at least one surface region is formed by a film portion (Column 3, lines 16 – 31; ink is considered a film) which is of a corresponding configuration and which is applied to the substrate and which comprises a material different from the substrate (Column 3, Lines 12 – 31) and which has openings through which the surface of the substrate can be felt (Figure 4, Items 1a, 2₅ and 2₆; projections would let an individual such as a blind person to feel the raised portions on the substrate which is between the film).

In regards to Claim 2, Tanaka further discloses a security document as set forth in claim 1, wherein the substrate and the film portion are formed by different kinds of film (Column 3, Lines 16 – 31; the substrate is a paper film and the film portion is ink film), which markedly differ in properties which can be detected by means of the human sense of touch (One can feel the difference between paper and printed indicia when running a finger across a sheet and the projections further enhance this ability for an individual).

In regards to Claim 6, Tanaka further discloses wherein the security document has a plurality of surface regions 1a, 1b which have different surface properties in relation to the substrate surface (Column 3, Lines 12 – 15; Figure 4, Items 1a, 1b; the portions are raised or recessed relative to the flat surface portions of the substrate).

In regards to Claim 7, Tanaka further discloses wherein the surface regions involve a differing configuration, size and/or surface nature (Column 3, Lines 12 – 15)

Response to Arguments

Applicant's arguments, see Remarks, filed February 1, 2008, with respect to the rejection(s) of claim(s) 1 - 17, and 19 under 35 U.S.C 102 and 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Senior, Chapman, and Castillo.

Allowable Subject Matter

Claims 3 – 5, and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claim 9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRADEEP C. BATTULA whose telephone number is (571)272-2142. The examiner can normally be reached on Mon. - Thurs. & alternating Fri. 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. C. B./
Examiner, Art Unit 3725
June 19, 2008

/Derris H Banks/
Supervisory Patent Examiner, Art Unit 3725